

### REMARKS

This responds to the Office Action mailed on August 12, 2005.

Claim 44 is amended, no claims are canceled, and no claims are added; as a result, claims 1-49 are now pending in this application. Claim 44, as noted in the Remarks section of the response mailed 2 February 2005, was previously amended into independent form. However, a strikethrough to indicate deletion of claim 44 dependency was inadvertently omitted. Claim 44 is currently amended to correct this typographical error. No new matter is introduced. Applicant respectfully requests reconsideration of the above-identified application in view of the amendment above and the remarks that follow.

#### Double Patenting Rejection

Claims 1 and 3-8 were provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 2-7 of co-pending Application No. 09/393,463 in view of "Feedback Cancellation in Hearing Aids: Results from a Computer Stimulation", by Kates and in further view of Kuo (U.S. Patent No. 6,097,823).

Claims 1, 2 and 9-16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 36-39 and 46-50 of co-pending Application No. 09/393,463 in view of "Feedback Cancellation in Hearing Aids: Results from a Computer Stimulation", by Kates and in further view of Kuo (U.S. Patent No. 6,097,823).

Claims 17-49 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-35 and 40-45 of co-pending Application No. 09/393,463.

Applicant will address these rejections when the claims are otherwise indicated as allowable.

#### §103 Rejection of the Claims

Claims 1, 3-5, 17, 18, 20-22, 41 and 43 were rejected under 35 USC § 103(a) as being unpatentable over "Feedback Cancellation in Hearing Aids: Results from a Computer Stimulation", by Kates in view of Kuo.

Claims 1-4, 6-8, 17, 20, 23, 25, 27-28, 39-41 and 49 were rejected under 35 USC § 103(a) as being unpatentable over Goodings et al. in view of Kuo.

Claim 19 was rejected under 35 USC § 103(a) as being unpatentable over Goodings et al. in view of Kuo and in further view of Thurmond et al. (U.S. 4,088,835).

Claims 1, 17, 23, 24, 26 and 28 were rejected under 35 USC § 103(a) as being unpatentable over Finn et al. in view of Goodings et al., and further in view of Kuo.

Applicant traverses these grounds of rejection of these claims. Further, Applicant reserves the right to swear behind Kuo and Finn et al. (hereafter Finn) at a later date.

In the Office Action, Kuo is cited in all rejections with respect to a narrowband probe. In the Office Action, it is stated, with respect to application of Kuo, that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a generator that generates a chirp signal (i.e. a chirp signal is an equivalent probe signal wherein at an instantaneous moment it is a narrow band signal) to inject into the system as a probe signal." However, Applicant cannot find in the combination of the cited references and Kuo a teaching or a suggestion of using an instantaneous moment of a chirp signal as a narrowband probe signal. For example, as recited in the instant claim 1, the probe signal itself is narrowband. A chirp signal made of numerous instantaneous moments does not make the chirp signal itself narrowband *per se*. The combination of the references and Kuo appears to be void of a teaching or a suggestion of a narrowband signal as recited in the instant claims. Further, the proposed modification of the combination of the cited references and Kuo is provided in the Office Action without a teaching or a suggestion for this modification found in the combination of the cited references and Kuo. Thus, the combination of the cited references and Kuo does not teach or suggest all the elements of claims 1-8, 17-28, 39-41, 43, or 49.

It is noted that "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). However, no reference or objective evidence has been provided in the Office Action to use an instantaneous moment of a chirp signal in the proposed combination of references as proffered in

the Office Action. Applicant submits that, without such reference or objective evidence to support the Office Action modification of the cited references and Kuo, application of the Office Action modification to establish a *prima facie* case of obviousness with respect to the abovementioned claims is not proper. *See, in re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant submits that the use of a narrowband probe signal, as recited in the instant claims, has only been provided in the Applicant's disclosure.

In the Office Action, it is stated that "Applicant has not clearly defined a 'narrowband subaudible probe signal' in the claim." Applicant submits that the definition of a term need not be stated in a claim, but rather the issue is whether one skilled in the art can understand the terms of a claim in light of the specification. Further, in the Office Action it is stated that a probe signal may be "multiple instantaneous moment of a chirp signal." However, if a probe signal is multiple instantaneous moments of a chirp signal, then the probe chirp signal itself is not *per se* a narrowband signal. Kuo (cited with respect to a chirp signal) uses a chirp signal and not an instantaneous moment processed from the chirp signal as a signal. In addition, Applicant cannot find in the combination of the cited references and Kuo a teaching or a suggestion regarding how to generate, from Kuo's chirp signal, an instantaneous moment signal as a narrowband signal.

Applicant submits that, since the only teaching or suggestion regarding a narrowband signal for use as recited in independent claims 1 and 17 is provided in the Applicant's disclosure, the cited combinations of references do not teach or suggest all the elements of claims 1 or 17. Thus, Applicant submits that claims 1 and 17 are patentable over the cited references for at least the reasons stated above. Further, the claims dependent on independent claims 1 and 17 are patentable over the cited references for at least the reasons stated above.

Applicant respectfully requests withdrawal of these rejections of claims 1-8, 17-28, 39-41, 43, and 49 and reconsideration and allowance of these claims.

#### Allowable Subject Matter

Claims 9-16, 29-38, 42, and 44-48 would be allowable if Applicant overcomes the Double Patenting rejection set forth in the Office Action. Applicant requests withdrawal of rejections of claims 9-16, 29-38, 42, and 44-48, and reconsideration and allowance of these patentable claims.



CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2157 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date

9 November 2005

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9 day of November, 2005.

KATE GANNON

Name

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Signature